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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/620,707      | 07/17/2003  | Seigo Ito            | 008312-0305056      | 9311             |

909 7590 08/24/2006

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EXAMINER

HALEY, JOSEPH R

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2627

DATE MAILED: 08/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/620,707

Applicant(s)

ITO, SEIGO.

Examiner

Joseph Haley

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 6/17/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-8,10-14,16,19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3,5-8,10-14,16,19 and 20 is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada (US 6442327) in view of Yoshiro (JP 2002093042) further considered with Keller et al. (US 6587403).

In regard to claim 1, Yamada teaches an information recording and reproduction apparatus comprising: a recording and reproduction section configured to record and reproduce information in and from one recording medium of a first group (fig. 19 element 7) and one recording medium of a second group, which has a smaller recording capacity than said one recording medium of the first group (fig. 19 element 6), however Yamada does not teach a control section configured to display the number of recording media of the second group, which need to be used when the recording and reproduction section records the information recorded in said one recording medium of the first group and a first selecting unit configured to select predetermined information from said one recording medium of the first group (see fig. 1 the user selects the video input signal).

Yoshiro teaches a control section configured to display the number of recording media of the second group, which need to be used when the recording and

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reproduction section records the information recorded in said one recording medium of the first group and a display unit configured to display the number of recording media of the second group, which need to be used when the recording and reproduction section records the information selected by the first selecting unit. (see abst where Yoshiro teaches displaying the number of CR-R's required for recording).

The two are analogous art because they both deal with the same field of invention of recording onto a smaller medium from a larger one.

At the time of invention it would have been obvious to one of ordinary skill in the art to provide the apparatus of Yamada with the display of Yoshiro. The rationale is as follows: At the time of invention it would have been obvious to provide the apparatus of Yamada with the display of Yoshiro because it would allow the user to know exactly how many of the smaller medium were required to successfully perform the task.

However, neither teach a second selecting unit configured to select the type of one recording medium of the second group.

Keller et al. teaches a second selecting unit configured to select the type of one recording medium of the second group (column 8 lines 30-35. Keller et al. establishes the fact that the use of two types of media is known in the art and therefore the use of and selection between two or more media in the present invention would be obvious).

The three are analogous art because they deal with the same field of invention of recording onto a smaller medium from a larger one.

At the time of invention it would have been obvious to one of ordinary skill in the art to provide the apparatus of Yamada in view of Yoshiro with the second selection

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unit of Keller et al. The rationale is as follows: At the time of invention it would have been obvious to provide the apparatus of Yamada in view of Yoshiro with the two media of Keller et al. because it would provide the user a choice between media of different sizes.

***Allowable Subject Matter***

Claims 3, 5-8, 10-14, 16 and 19-20 are allowed.

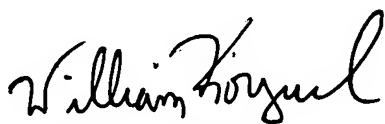
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Haley whose telephone number is 571-272-0574. The examiner can normally be reached on M-F 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Korzuch can be reached on 571-272-7589. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jrh



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